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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,042	05/14/2001	David A. Solin	1220	8654

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EXAMINER

ROBINSON, GRETA LEE

ART UNIT

PAPER NUMBER

2177

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,042

Applicant(s)

SOLIN, DAVID A.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 are pending in the present application.
2. Fujita was cited as prior art in the last office action (paper number two); the rejection is respectfully maintained.

Drawings

3. The drawings were received on November 18, 2003. These drawings are approved.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the following limitation is vague: "requesting at least one second set of update information responsive to at least a size of the first set of update information". The structural connection between this limitation and the updating the computer system responsive to at least the first set of update information is not clear.

The limitations of independent claim 8 and claim 15 parallel the limitation of claim 1; therefore they are rejected under the same rationale.

Regarding independent claims 5, 12 and 19 the following limitation is vague and unclear: "occasion". This meaning of the term is not clear; Applicant does not appear to use this term in the disclosure.

Claims 2-4, 6-7, 9-11, 13, 14, 16-18, 20 and 21 are rejected based on dependency.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujita (US Patent 5,386,553).

Fujita teaches a method of updating a computer system [note: "updating instructions" s10, figure 8], the method comprising:

receiving at least one first set of update information [note: col. 4 lines 62-68];

requesting at least one second set of update information responsive to at least a size of the first set of update information [col. 4 line 68 through col. 5 line 11; figure 3 note "amount of data information" 10] ; and

updating the computer system responsive to at least the first set of update information received [see: abstract; figure 8 note updating; col. 2 line 53 through col. 3 line 31; col. 3 line 32-52; col. 6 lines 20-27; col. 9 line 42 through col. 10 line 23].

Fujita teaches file updating in which the type of updating is responsive to the amount of data or file size.

8. Regarding claims 2 and 4:

(claim 2) wherein the updating step comprises deleting at least one set of information, said at least one set of information stored on the computer system prior to the receiving step, responsive to the first set of update information received [col. 8 lines 30-62; col. 7 lines 19-25].

(claim 4) wherein the requesting step is additionally responsive to a size of an area into which information may be stored [abstract; figure 3 note "amount-of-data information" (10); col. Col. 3 lines 45-52 "changing a size of the disk file according to the type of updating operation to be performed and the amount of data represented by the amount-of-data information"].

9. Regarding claim 3:

receiving at least one third set of update information ... a difference in times between a performance of each of the receiving the third set of update information and the updating [note: Fujita teaches predetermined timing see col. 7 lines 25-35].

10. Regarding claims 5-7:

requesting on a first occasion a first set of update information for a first set of information responsive to a list comprising at least one identifier of the first set of information ... modifying the first set of information responsive to the first set of update information received ... [note: col. 2 lines 24-30; col. 2 line 53 through col. 3 line 31; col. 5 lines 12-35; col. 7 lines 19-25].

11. The limitations of computer program product claims 8-14 and system claims 15-21 parallel method claims 1-7; therefore they are rejected under the same rationale.

Response to Arguments

12. Applicant's arguments filed November 18, 2003 have been fully considered but they are not persuasive.

In the response Applicant argued the claim language is clear with respect to the independent claims. Regarding claims 1, 8 and 15, Applicant states, "the first set of update information has a size". A second update information may be requested based on the size of the first set of update information [note: page 14-15 of Applicant's response]. The examiner respectfully maintains that the claim is vague because the present claim limitation **does not state** that the first set of update information has a size, the connection between the elements in the claim are vague and unclear. For example, the claim does not set out as to what element is "receiving" the update information or "requesting" the at least second set of update information. Is there a

client/server network? This argument also, applies to claims 5, 12, and 15. Who or what is requesting the update information. Applicant's explanation of what is meant by the term "occasion" is not convincing. The examiner notes that this term is not defined or used in the disclosure. Fujita does address updating files as claimed. Fujita teaches updating information based on the amount of information note col. 2 lines 58-63, also note col. 5 lines 8-11.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cannon et al. US Patent 6,021,415 *teaches storage management with file aggregation and space reclamation within aggregated files*

Tada US Patent 5,724,552 *teaches when the data size threshold value is changed, the data stored in HDD 55 is also updated*

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.



GRETA ROBINSON
PRIMARY EXAMINER

Greta Robinson
Primary Examiner
January 30, 2004